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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/998,639 | 12/03/2001 | Shu Hotta | HOTTA-2A | 7639 |

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BROWDY AND NEIMARK, P.L.L.C.
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EXAMINER

YAMNITZKY, MARIE ROSE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1774

DATE MAILED: 08/13/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,639

Applicant(s)

HOTTA ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1774

1. This Office action is in response to applicants' amendment filed June 12, 2003 (Paper No. 7), which cancels claims 1-22 which were entered as a result of the entry of the substitute specification filed February 19, 2002, and adds claim 23 which corresponds to claim 1 as originally filed on December 03, 2001.

Applicants' amendment renders moot the election of species requirement as set forth in Paper No. 6.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Sakon et al. (US 5,077,142) or Nobutoki et al. in *J. Phys. Chem.*, Vol. 100, No. 16, 1996, pp. 6451-6455.

Sakon et al. anticipate a compound having the molecular structure set forth in present claim 23 wherein each of m_1 , m_2 and n is 1 and each of R_1 and R_2 is hydrogen. See the formula at column 102, lines 40-45. Sakon et al. also anticipate a compound having the molecular structure set forth in present claim 23 wherein n is 1, each of m_1 and m_2 is 2, and each of R_1 and R_2 is hydrogen because one of ordinary skill in the art at the time of the invention could have at once envisaged this compound based on Sakon's disclosure that Ar of formula (I) as set forth in claim 1 of the patent can be biphenyl instead of phenyl.

Art Unit: 1774

Nobutoki et al. anticipate compounds having the molecular structure set forth in present claim 23 wherein (a) each of m_1 , m_2 and n is 1, and each of R_1 and R_2 is hydrogen, (b) each of m_1 , m_2 and n is 2, and each of R_1 and R_2 is hydrogen, (c) each of m_1 , m_2 and n is 3, and each of R_1 and R_2 is hydrogen, and (d) each of m_1 , m_2 and n is 4, and each of R_1 and R_2 is hydrogen. See the whole article, especially the paragraph bridging the two columns on page 6451 and Figures 1 and 3-8.

4. The examiner also notes that on page 40 of the present specification, applicants admit that a compound having the molecular structure set forth in present claim 23 wherein each of m_1 , m_2 and n is 1, and each of R_1 and R_2 is hydrogen, is known.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,355,365 B1. Although the

Art Unit: 1774

conflicting claims are not identical, they are not patentably distinct from each other because a compound as claimed in the present claim is a component of the luminous material claimed in patent claim 1, and the presently claimed compound wherein n is 4 or more is a component of the organic electroluminescence element of patent claims 2 and 3.

The election of species requirement set forth in the parent application does not preclude this rejection because present claim 23 reads on the species that was elected in the parent application.

7. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax numbers for Art Unit 1774 are (703) 872-9311 for official after final faxes and (703) 872-9310 or (703) 305-5408 for all other official faxes. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (703) 872-9041.)

MRY
August 08, 2003



MARIE YAMNITZKY
PRIMARY EXAMINER

1774